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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* DALE F. McINTYRE  
and KENNETH A. PARULSKI

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Appeal 2009-001182  
Application 09/891,474<sup>1</sup>  
Technology Center 2400

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Decided: August 26, 2009

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Before LEE E. BARRETT, HOWARD B. BLANKENSHIP, and  
JAY P. LUCAS, *Administrative Patent Judges*.

BARRETT, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the final  
rejection of claims 1-15. We have jurisdiction pursuant to 35 U.S.C. § 6(b).

We reverse and enter new grounds of rejection.

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<sup>1</sup> Filed June 26, 2001, titled "System and Method for Managing Images Over a Communication Network."

## STATEMENT OF THE CASE

### *The invention*

The invention relates to a system and method for creating an electronic icon containing information unique to a particular user including information allowing access with respect to a particular digital media file having the icon associated therewith over a communication network by a third party. The device for creating an electronic icon containing information unique to a particular user may be a computer programmed to allow a user to select a portion of a user's image as shown in Figures 10a and 10b. Spec. 20, ll. 16-23. The icon is a form of content identifier. Spec. 20, ll. 21-23. The content identifier is stored in association with images along with metadata identification information used to identify who can view the images. Spec. 9, ll. 7-24.

### *The claims*

Independent claims 1 and 11 are reproduced below:

1. A system for managing digital images, comprising:

a device for creating an electronic icon containing information unique to a particular user including information allowing access with respect to a particular digital media file having said icon associated therewith over a communication network by a third party.

11. A method for managing digital images by a service provider on a computer of a user over a communication network, comprising:

Appeal 2009-001182  
Application 09/891,474

creating an electronic icon containing information unique to said user that includes information for allowing controlled access by a designated third party to a particular digital media file stored on said computer;

said service provider accessing said computer over said communication network and locating digital media files having said icon associated therewith and allowing access to said digital media files by said designated third party.

*The references*

Angiulo	US 6,275,829 B1	Aug. 14, 2001 (filed Nov. 25, 1997)
Watanabe	US 6,578,072 B2	Jun. 10, 2003 (filed Dec. 31, 1998)
Uchiyama	US 6,731,341 B1	May 4, 2004 (filed Mar. 15, 1999)
Tomat	US 6,784,925 B1	Aug. 31, 2004 (filed Mar. 24, 1998)
Motoyama	US 2001/0054063 A1	Dec. 20, 2001 (filed Mar. 10, 1998)

*Newton's Telecom Dictionary* (16th ed. Feb. 2000), definition of "icon."

*The rejections*

Claims 1, 2, 4, 9, and 11-14 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Angiulo and Watanabe.

Claims 3, 5, 6, and 8 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Angiulo and Watanabe, further in view of Tomat.

Claim 7 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Angiulo, Watanabe, and Tomat, further in view of Motoyama.

Appeal 2009-001182  
Application 09/891,474

Claim 10 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Angiulo, Watanabe, and Tomat, further in view of Uchiyama.

Claim 15 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Angiulo and Watanabe, further in view of "Official Notice" that decreasing the resolution of a media file was well known.

#### NEW GROUNDS OF REJECTION

Claims 1-10 are rejected under 35 U.S.C. § 112 ¶ 1 based on lack of enablement for the full scope of the claim. In particular, claim 1 is an impermissible single means claim and claims 2-10 depend from it. *See In re Hyatt*, 708 F.2d 712, 714-15 (Fed. Cir. 1983) (a single means claim which covers every conceivable means for achieving the stated purpose is nonenabling for the scope of the claim because the specification disclosed at most only those means known to the inventor).

Claim 1 recites a single "device" for performing a function and a "device" is equivalent to a "means." "The generic terms 'mechanism,' 'means,' 'element,' and 'device,' typically do not connote sufficiently definite structure [to avoid 35 U.S.C. § 112 ¶ 6]." *Mass. Inst. Of Tech. v. Abacus Software*, 462 F.3d 1344, 1354 (Fed. Cir. 2006). Thus, claim 1 is an impermissible single means claim.

Claims 1-15 are rejected under 35 U.S.C. § 112 ¶ 2 for failing to particularly point out and distinctly claim the invention. Claim 1 recites "a device for creating an electronic icon containing information unique to a particular user including information allowing access with respect to a

particular digital media file having said icon associated therewith over a communication network by a third party"; that is, a "device for creating an electronic icon," the icon having two kinds of information: (1) "information unique to a particular user"; and (2) "information allowing access with respect to a particular digital media file having said icon associated therewith over a communication network by a third party." The "device" is disclosed to be a computer programmed to allow a user to select a portion of an image using a pointing device as shown in Figures 10a and 10b or an unidentified algorithm for identifying content. Spec. 20, ll. 16-23. The "electronic icon containing information unique to a particular user" is interpreted to refer to the icon 202 in Figure 10b, where the "information unique to a particular user" is the image on the icon; the unique information is not limited to the user's appearance.

What appears indefinite is the limitation of the "electronic icon . . . including information allowing access with respect to a particular digital media file having said icon associated therewith over a communication network by a third party." As we understand the Specification, this information is metadata associated with file, not part of the icon. The Specification describes:

For the purposes of the present invention, an image media file includes a digital image file (high or low resolution) and can also include additional data such as associated audio or metadata. . . .

The user computer 10 is provided with appropriate software for allowing controlled access to a high resolution image media collection, such as a database, stored on memory storage device 14.

The high resolution image media collection comprises at least one high resolution image media file and as previously discussed can include associated digital data. A low resolution copy of each high resolution digital image file along with any associated meta data/information (the combination of both files hereinafter referred to as the user low resolution image collection) is electronically sent to the service provider 80 for storage at the service provider 80 and is associated with the user. One way in which an image can be associated with a user is the addition of metadata to the image media files(s) that reflects a specific user identifier such as a user account number, a user provided identifier with any combination of alphanumeric characters, or any other construct in the form of metadata.

Spec. 7, l. 13 to Spec. 8, l. 1 (emphasis added). The Specification further describes:

As previously discussed, in addition to the low resolution images stored at the service provider 80, there can be stored various other data/information related to these images. This information can be used to identify who can have access to the low resolution image and information that describes the content of the images.

Spec. 8, ll. 18-22 (emphasis added). In particular, we note the last sentence. The Specification still further describes:

Further information can be provided to the service provider 80 for assisting in identifying content of the images and/or individuals that can have access to the images. For example, an image icon 202, such as illustrated in FIG. 10b can be used as a content identifier to first identify content of images forwarded to the service provider 80. In the embodiment illustrated, the image icon 202 is in the form of the face of an individual taken from image 206 of FIG. 10a. . . . When such images are identified, the identification information is recorded as metadata and stored in association with that image. The identification information can be used to identify who can view this

Appeal 2009-001182  
Application 09/891,474

image at the service provider 80 or even provide an automatic forwarding of the image to a specified individual.

Spec. 9, ll. 7-22 (emphasis added). The Specification states that "[t]he selected image content identifier forms the image icon 202 as shown by FIG. 10b which is a form of content identifier." Spec. 20, ll. 21-23.

Therefore, the Specification describes that the "information allowing access with respect to a particular digital media file having said icon associated therewith over a communication network by a third party" is metadata stored in association with an image that is separate from the icon information (which is a form of content identifier). It does not appear that the information allowing access is part of the electronic icon information, as claimed. An electronic icon is just an electronic representation of an image and does not itself include other data. It is as if the phrase "an electronic icon containing information unique to a particular user including information allowing access," which requires the "information allowing access" to be part of the electronic icon information, should be something like "an electronic icon containing information unique to a particular user; the system including information allowing access" to be consistent with the Specification. Similar comments apply to claim 11.

## ISSUE

Have Appellants shown that the Examiner erred in finding that the combination of prior art teaches or suggests "a device for creating an electronic icon containing information unique to a particular user including

Appeal 2009-001182  
Application 09/891,474

information allowing access with respect to a particular digital media file having said icon associated therewith over a communication network by a third party" as recited in claim 1 and the step of "creating an electronic icon containing information unique to said user that includes information for allowing controlled access by a designated third party to a particular digital media file stored on said computer" as recited in claim 11?

## FACTS

### *Angiulo*

Angiulo describes a method for enabling a user to automatically introduce a thumbnail image into a Web page to represent an original image. A link to the original image is automatically provided and associated with the thumbnail image in the Web page, so that the original image is retrieved and displayed if the thumbnail image is selected. Col. 5, l. 61 to col. 6, l. 9.

### *Watanabe*

Watanabe describes a network photograph service in which images are disclosed on a network only to persons that a user allows to browse through the images. Col. 2, ll. 25-27.

Watanabe described that in a conventional network photograph service, disclosure of thumbnail images is carried out by grouping images registered at the same time. In other words, when the user requests registration of all images recorded on a film, one register ID and one register password are issued for the entire group of images. The user can browse through all images by inputting the register ID and the password to the

system. Col. 6, ll. 57-67. For example, in Figure 3, a user could browse through all images in Register Group A or Register Group B with the appropriate register ID and register password.

The system of Watanabe is characterized by letting the user set an image group as a unit of disclosure, called a network album, in addition to the image disclosing function in units of registration. Col. 7, ll. 1-7. In Figure 3, the images within frame 101 in Register Group A could be assigned to Album 1; the images within frame 102 in Register Group A and frame 104 in Register Group B are assigned to Album 2; the images within frames 103 and 104 in Register Group B are assigned to Album 3 (note that arrow from 104 to Album 3 is missing). Col. 7, ll. 8-59.

## CONTENTIONS

The Examiner finds that Angiulo teaches a device for creating an electronic icon (the thumbnail version of an image) and associating the icon with information allowing access with respect to a digital media file (a hyperlink to the original high resolution image). Final Rej. 2. The Examiner finds that Angiulo does not teach that the icon contains information allowing access and information unique to a particular user. *Id.* The Examiner finds that Watanabe teaches thumbnails containing information unique to users and information for allowing access to be included with the icon. *Id.* at 3. The Examiner concludes that it would have been obvious to combine the teachings of Angiulo and Watanabe to have an icon containing information unique to users and information allowing access

Appeal 2009-001182  
Application 09/891,474

because it would distinguish each thumbnail, allowing selective viewing of pictures by users. *Id.*

Appellants argue that the thumbnail image of Angiulo does not teach the limitations of claims 1 and 11:

The thumbnail image of Angiulo contains information to a particular (i.e., original) image, not information unique to a particular user as claimed by applicants. *See* Col. 7, lines 28-39. This user is not the same as a third party as claimed by applicant. In the present invention the third party is separate and distinct from the user of the icon that associates the icon with the image.

Br. 4.

Appellants argue that thumbnail image of Watanabe does not cure the deficiencies of Angiulo:

At best, Watanabe discloses that a serial number can be associated with each thumbnail image 25 and an image ID 29 maps the thumbnail image 25 to the network album. The album can be associated with more than one user. This is in contrast with the present invention where an electronic icon is associated with a particular user.

Furthermore, to access an album, the user must input a user ID and user password at a browser. In sharp contrast, in Applicants' invention, the electronic icon contains information unique to a particular user including information allowing access with respect to a particular digital media file by a third party.

Br. 4-5 (citations omitted).

Appellants conclude that "[b]oth Watanabe and Angiulo fail to teach an icon that includes information allowing access to a particular media file

Appeal 2009-001182  
Application 09/891,474

over a communication network by a third party as taught and claimed by Applicants." Br. 5.

## ANALYSIS

As noted in the new ground of rejection under 35 U.S.C. § 112 ¶ 2, the recitation in claims 1 and 11 that the electronic icon includes information for allowing access is considered misdescriptive because the Specification describes that the information allowing access is metadata separate from the icon. That is, the electronic icon is only electronic data corresponding to an image and does not include access information (nor is it clear how the icon alone would contain access information). Nevertheless, we consider the rejection based on the claims as presented.

We agree with the Examiner that the thumbnail image in Angiulo contains "information unique to a particular user" because the original image from which the thumbnail is derived is unique to the user presenting the image. The "information unique to a particular user" is not defined to be an image of the user, but could be any unique information.

We agree with the Examiner that the hyperlink in Angiulo is "information allowing access with respect to a particular digital media file having said icon associated therewith over a communication network by a third party" because the hyperlink provides access to the original image media file and the thumbnail (icon) is associated with the original image. The hyperlink allows access over a network by a third party, who may be any person who clicks on the thumbnail. Claim 1 does not require

"controlled access" or a "designated third party" as in claim 11. However, the hyperlink information is not included as part of the electronic icon, and therefore does not meet the precise wording of the claims.

Watanabe also describes "information allowing access with respect to a particular digital media file having said icon associated therewith over a communication network by a third party" in the form of a network album name and a network album password. Col. 9, ll. 1-7, 43-54. However, this information is not included as part of the electronic icon, and therefore does not meet the precise wording of the claim.

Claim 1 is a single means claim. The only structure disclosed is a computer. Although the computers in Angiulo and Watanabe are capable of performing the function, they do not describe programming a computer to perform the described function and do not make the claimed subject matter obvious. *See In re Prater*, 415 F.2d 1393, 1406 (CCPA 1969) ("Assuming the existence, at the time of the invention, of general-purpose digital computers as well as typical programming techniques therefor, it is nevertheless plain that appellants' invention, as defined in apparatus claim 10, was not obvious under 35 U.S.C. § 103 because one not having knowledge of appellants' discovery simply would not know what to program the computer to do."). *See also In re Mills*, 916 F.2d 680, 682 (Fed. Cir. 1990) ("While Mathis' apparatus may be capable of being modified to run the way Mills' apparatus is claimed, there must be a suggestion or motivation in the reference to do so.").

Appeal 2009-001182  
Application 09/891,474

Therefore, based on the claims presented, we find that the combination of references does not teach "an electronic icon . . . including information allowing access with respect to a particular digital media file having said icon associated therewith over a communication network by a third party" as recited in claim 1 or "an electronic icon . . . that includes information for allowing controlled access by a designated third party to a particular digital media file stored on said computer" as recited in claim 11. The dependent claims are argued to stand or fall with the independent claims. Accordingly, the rejections of claims 1-15 are reversed.

## CONCLUSION

The rejections of claims 1-15 under 35 U.S.C. § 103(a) are reversed. New grounds of rejection are entered as to claims 1-15.

This decision contains new grounds of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides that "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that the appellant, **WITHIN TWO MONTHS FROM THE DATE OF THE DECISION**, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

Appeal 2009-001182  
Application 09/891,474

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

Requests for extensions of time are governed by 37 C.F.R. § 1.136(b).  
*See* 37 C.F.R. § 41.50(f).

REVERSED -- 37 C.F.R. § 41.50(b)

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